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-- REMARKS --

Claims 1-20 remain under consideration. The claims have not been amended in response to the Advisory Action.

INTERVIEW SUMMARY

Applicant's Counsel Lawrence E. Crowe expresses his appreciation to the Examiner for the courtesy extended by the Examiner during a telephone interview initiated by Mr. Crowe on November 3, 2003. During that interview the Examiner stated that he did not have the case file in his possession and stated that he would retrieve the file after receiving a written response to the Advisory Action dated October 6, 2003, and reconsider the Advisory Action in light of Applicant's remarks in the written response. Applicant's Counsel expressed his disappointment that the Examiner had not granted Applicant's written request, in Applicant's response filed September 17, 2003 to the Final Office Action dated August 26, 2003, that the Examiner contact Applicant's Counsel to arrange a formal telephone interview in the event that the Examiner elected to continue the final rejection after considering Applicant's response thereto. The Examiner assured Applicant's Counsel that a formal interview would be arranged following receipt of this response and his retrieval of the file.

The need for expressly reciting details of a feed for the antenna of the invention in claims utilizing a "consisting essentially of" transitional phrase was also briefly discussed, without resolution.

Also discussed was an ambiguity in the Advisory Action, stating in paragraph 2 thereof, that proposed amendments would not be entered. The ambiguity arises because Applicant's response to the final Office Action did not include any amendments. The Final Office Action responded to claims as amended by Applicant in a Response dated May 12, 2003 in a non-final Office Action dated February 12, 2003, which stated in paragraph 3 thereof that Applicant's amendment necessitated new grounds of rejection stated in the Final Office Action, thereby

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indicating that all amendments made by the Applicant had already been entered. The statement in the present Advisory Action that amendments would not be entered appears to be in conflict with the Final Office Action. The Examiner was unable to explain the apparent ambiguity/conflict between the present Advisory Action and the Final Office Action, without having the file in front of him.

REQUEST FOR RESETTING TIME PERIOD FOR RESPONSE

In light of the ambiguity that is created by the conflict between the present advisory action and the Final Office Action, regarding the status of the claims, Applicant requests that the finality of the Office Action be rescinded and that the time for response be reset.

Applicant also respectfully restates his position, as stated in response to the Final Office Action, that all rejections in the Final Office Action were improper, because the Examiner clearly did not examine Applicant's claims 1 and 13 utilizing the "*consisting essentially of*" transitional phrase used in those claims, but instead erroneously applied the more restrictive "*consisting of*" transitional phrase, and based his rejection upon that error. The Final Rejection was thus premature, erroneous, and incomplete, in that the Examiner did not examine the claims as actually presented, and thereby deprived the Applicant of both a proper second Office Action on the merits and a proper basis from which to respond. The Examiner has thus not provided a proper examination on the merits of Applicant's claims as amended in the Response submitted May 12, 2003, to the previous non-final Office Action dated February 12, 2003, thereby providing ample grounds for withdrawal of the Finality of that Office Action and a further proper examination on the merits of Applicant's claims as amended in response to the non-final Office Action dated February 12, 2003.

REQUEST FOR RECONSIDERATION OF CLAIM REJECTIONS UNDER 35 USC § 112

In response to the present Advisory Action, and in light of the attached Declaration from the Inventor under 37 USC § 1.132, Applicant traverses and respectfully requests reconsideration

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of the rejection under 35 USC § 112.

The following quotation from MPEP § 2111.03 forms part of the basis for traversing all rejections set forth in the Office Action:

2111.03 Transitional Phrases

The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

"A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988).

The rejection of claims 1-20 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, is traversed.

Independent claims 1 and 13, both include the transitional phrase "consisting essentially of." In paragraph 2 of the Final Office Action the Examiner states that he is rejecting claims 1 and 13, together with claims 2-12 and 14-20 depending respectively from claims 1 and 13, "[b]ecause claims 1 and 13, with the amendment concerning "consisting of", do not recite a feed for the antenna and without the feed the recited device can not function." In the present Advisory Action, the Examiner maintained the rejection, stating, in a continuation of paragraph 2

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of the Advisory Action, that, "*the type and positioning of an antenna feed structure is a material feature of an antenna effecting its impedance and radiation characteristics.*"

Applicant agrees with the Examiner's comment in the Final Office Action, as quoted above, that without a feed that the recited device cannot function. Applicant further notes, however, that the Examiner's comment serves as clear evidence that one skilled in the art would readily recognize that a device, as recited in claims 1 and 13, having an antenna consisting essentially of a substrate of dielectric material defining a longitudinal axis of the substrate and a surface of the substrate, and a plurality of electrically conductive elements disposed on the surface of the substrate to form a Yagi-Uda dipole array, would include a feed for the Yagi-Uda array.

As clearly stated at page 7, lines 1-2, of the Application, the feed of the Yagi-Uda antenna of Applicant's invention "may be made in any appropriate fashion known to those having skill in the art." The Application provides several examples of methods for providing a feed, using techniques known in the art, which are appropriate for use with a Yagi-Uda array as required by claims 1 and 13 and all claims depending therefrom, and are distinct from the prior art cited by the Examiner in the previous Office Action. See, Application page 7, lines 2-9.

As indicated by the attached Declaration, the Inventor has discovered that an antenna constructed according to the present invention provides properties including an inherently high input impedance that makes the type and positioning of the antenna feed far less critical than is the case in prior antennas, so that the type and positioning of an antenna feed structure is not a "*material feature of an antenna effecting its impedance and radiation characteristics.*" in the context suggested by the Examiner in the Advisory Action. The manner in which the feed is made does not materially affect the characteristics of the Applicant's invention, and is therefore properly included within the scope of the "consisting essentially of" transitional phrase of these claims, even though the feed is not expressly recited.

Applicant's Declaration augments extensive discussion provided in the Response submitted May 12, 2003 to the previous Office Action dated February 12, 2003, as to how

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additional elements in the cited prior art, relating to the feed and impedance matching elements required by the prior art but not Applicant's invention, as expressed by the Applicant's disclosure and expressly excluded from the claims of the present Application through use of a consisting essentially of transitional phrase, would materially change the characteristics of the Applicant's invention, and would materially affect the basic and novel aspects of the Applicant's invention as claimed. Applicant restates that discussion herein by reference.

Claims 2-12, depending from claim 1, and claims 14-20, depending from claim 13, all properly further restrict the express limitations of claims 1 and 13, in accordance with the "consisting essentially of," transitional phrases used in claims 1 and 13, and are therefore also completely enabling and not subject to rejection under the first paragraph of 35 USC 112.

SUMMARY

Applicants believe that the application is in condition for allowance. Reconsideration and notification of allowance are respectfully requested.

REQUEST FOR FORMAL INTERVIEW

Applicant requests that the Examiner contact Applicant's counsel, Lawrence E. Crowe at 815-393-4644 to arrange a formal telephone interview.

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PROCEDURAL MATTERS AND FEES

Applicant authorizes payment of a 1-month extension fee. Applicant believes that no additional fees are occasioned by the submittal of this paper. The commissioner is authorized, however, to charge any fees or credit any refunds occasioned by submittal of this paper to deposit account number 07-0960.

Dated: December 24, 2003

Respectfully submitted,
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